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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 32

Application Number: 08/901,713
Filing Date: July 28, 1997
Appellant(s): BELL, ANDREA F.

Stephen T. Sullivan
For Appellant

EXAMINER'S ANSWER

MAILED
DEC 20 2002
GROUP 3

This is in response to the appeal brief filed October 9, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-31 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c) (7) and (c) (8). Appellant's brief indicates that claims 1, 2, 9-11, 18-20, and 27-31 stand or fall together; claims 3, 12, and 21 stand or fall together; claims 4, 13, and 22 stand or fall together; claims 5, 14, and 23 stand or fall together; claims 6, 15, and 24 stand or fall together; claims 7, 16, and 25 stand or fall together; claims 8, 17, and 26 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,678,977	BAUMGARTNER	7-1972
4,993,551	LINDSAY	2-1991

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5,431,265

YOO

7-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-31 are rejected under 35 U.S.C. 103(a) over Lindsay in view of Baumgartner. This rejection is set forth in prior Office Action, Paper No. 26 (see paragraphs 2).

Claims 1-31 are rejected under 35 U.S.C. 103(a) over Lindsay in view of Baumgartner as applied to claims 1-31 (in paragraphs 2), and further in view of Yoo. This rejection is set forth in prior Office Action, Paper No. 26 (see paragraphs 3).

(11) Response to Argument

The examiner readily agrees with the Applicant that the subject matter of each of Baumgartner and Yoo is not in Applicant's field of endeavor since neither reference is concerned with utility aprons nor with cleaning of residential or commercial buildings.

The examiner is not in agreement with the Applicant's view that the subject matter of each of Baumgartner and Yoo does not involve a field reasonably pertinent to the particular problem with which the Applicant was concerned. Baumgartner (col. 2, line 17-19) calls for an elastic band to be along the edge of a pocket (25) for retention of objects/items placed in the pocket. Similarly, Yoo (col. 4, line 68 through col. 5, line 3) calls for compartments (soft compartments 28) to include a piece of elastic sewn in an opening edge thereof for the purpose of holding an item in the pocket opening. This function appears closely related to Applicant's function since Applicant's specification description (page 5, lines 7-10) calls for pockets

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to have resilient openings so that when an item is placed in the pocket, the pocket will return to its normal size to retain the item in the pocket.

The fields of endeavor of the references are reasonably pertinent also with respect to the items to be retained. Both Applicant and the references are concerned with the storage and retention of items. While Applicant argues bottles of cleaner as being the items, Yoo's items include shampoo, conditioner or perfume. Such items often come in a bottle or a tube. However, the kind of item described by Applicant's specification may also include sponges and cleaning cloths (see page 5). The cleansing tissues of Baumgartner constitute cleaning cloths. Moreover, Baumgartner is sufficiently related to Lindsay since Baumgartner also concerns the storage and retention of tools/implements, such as pens and pencils (col. 2, line 23).

The examiner agrees that the intended stored items of Lindsay do not include cleaning items, but tools. Accordingly, the Lindsay holder is a utility apron for tool items. Applicant does not positively recite cleaning items in any of the claims. Moreover, the functional limitations which happen to call for containing an *item* (only in dependent claims 5-8, 14-17 and 23-26) do not refer to the item as being a cleaning item, even though Applicant appears to stress such a difference. Accordingly Applicant's argument that Lindsay is not for cleaning items fails to have support in the claimed subject matter.

An argument that Lindsay does not concern the retaining of items in the pockets against inadvertent removal (i.e., falling out) would also appear to lack claim support since Applicant's claimed functional language does not call for the retaining of items, but the containing of items.

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The examiner believes that there is motivation to combine the teachings of Baumgartner and Yoo with the subject matter of Lindsay in order to retain Lindsay's *items* in their pockets. From Baumgartner a motivation particularly comes from specification column 2, lines 18-19. From Yoo a motivation comes from specification column 5, lines 2-3. The examiner asserts that *holding* (taught by Yoo) is sufficiently related to retaining. The Yoo teaching even considers holding in an opening. The examiner also believes that the motivation is ample, regarding obviousness (to one of ordinary skill in the art), to have modified the pockets of Lindsay with elastic at the opening thereof for the purpose of retaining the items of Lindsay in their pockets.

The examiner agrees with the Applicant that there are a few times when change in size can provide a basis for patentability. The examiner, however, does not agree that such is the case here. Applicant's use of pocket size and Applicant's limitations regarding pocket size appear to operate merely to give the pockets a desired capacity, in this case an inherent function of size. It is the examiner's opinion that size changes essentially for creating a desired capacity would have been obvious expedients in view of the legal precedents of In re Rose, 105 USPQ 237, 240 (CCPA 1955) and In re Yount, 80 USPQ 141, both of which concerned containers/packaging.

The examiner maintains that when the evidence of obviousness in the prior art is considered along with the evidence of non-obviousness provided by the declarations of George E. Millican, Jr. (Millican), Andrea F. Bell (Bell), and Gary Cohen (Cohen), the evidence of the prior art is stronger. The following reasons are the basis for this position taken by the examiner.

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Firstly, the examiner believes that there are statements made by the **Millican** declaration that lack a nexus with the claimed invention. Paragraph 6 of the declaration refers to a bucket or a caddy. No bucket or caddy is called for in the claims.

The examiner believes that the Millican declaration lacks probative value since it lacks any evidence that shows one of the following: unexpected results, commercial success, solution of long-felt need, inoperativeness of a reference, invention before the date of a reference, or an allegation of an author of one of the references that his invention was derived from the applicant.

Specifically, regarding unexpected results, no showing in the Millican declaration appears to have been made, that the use of an elastic in a pocket opening of a utility apron would function in an unexpected manner. In fact, the declaration in paragraph 7 tends to support the notion that the elastic would function in the same manner as is taught or is evident in the prior art.

Specifically regarding a solution of long-felt need, the declaration of Millican appears to have failed to establish that a solution has been made with respect to the known closest prior art device, such as an apron like that of Lindsay. The closest known device mentioned in paragraph 6 of the declaration is a caddy or bucket; no apron is mentioned. Although paragraph 7 does mention *prior utility aprons*, it fails to indicate a need that was *long-felt*, to which the invention provided a solution. No factual data, such as multiple or ongoing events of mishaps or problems with prior aprons, and dates of such events, has established a long-felt need regarding improvement over such aprons.

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At most, the Millican declaration appears to give a showing of novelty, not unobviousness, since the declaration merely points out what is evident from a comparison of the disclosure of the invention with the device of Lindsay, that the invention distinguishes over the prior art aprons by providing a resilient material in the pocket.

The examiner has not been persuaded that the **Bell** declaration sufficiently establishes long-felt need. It is unclear from the declaration just how many times the declarant saw a pocket being ripped by stuffing oversized items therein. Moreover, there is no factual indication that anyone but declarant/Applicant may have had this difficulty. Moreover, it is unclear how long the declarant had this problem. No documentation, such as a memo to employees to stop stuffing oversized contents into the pockets, appears to corroborate that this problem existed.

The Bell declaration states that often in attempting to stuff and remove a large container into/from a non-resilient pocket of the prior art, this ripped the pocket or disengaged the pocket from the bucket. However, the examiner has not been persuaded that *pocket rips* due to the cramming of too-large objects can be solved by merely providing elastic in the mouth of the pocket. Placing elastic in a pocket material will not increase the capacity of the pocket. Therefore, trying to stuff an oversized object into a pocket which has an elastic mouth will not prevent the pocket from ripping when the material is overstressed due to excessive tension. Moreover, it appears that the accidental disengagement of a pocket caddy from its bucket when trying to remove an oversized object from the pockets will not be overcome by placing elastic in the pocket mouth. Apparently, the correct answer to such a problem is to make the pockets larger.

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However, the improvement that elastic provides to larger pockets, i.e. that of grasping the contents of the pockets, is already suggested in the art (as applied).

In addition, the examiner has not been persuaded that the Bell declaration demonstrates commercial success. The Bell declarant states that 4,000 units of the claimed invention have been sold to date. But it is unclear from the declaration what length of time is meant by "to date." The declaration states that development began in 1996. However, it is unclear when the declarant first provided the product for sale.

In addition, there is no way for the examiner to determine the importance of the number 4,000 since the declarant has failed (or was unable) to disclose what percentage of the pocket caddy market this represents.

In addition, it is unclear how much Applicant invested in marketing and advertising to achieve the sale of the 4,000 units. Also it is unclear whether the price was greater or less than the nearest competitor (which presumably did not have elastic pockets).

The Bell declaration has stated that the product has been sold to retailers but has provided no details of these transactions to permit the examiner to determine the commercial success.

Regarding the Sacramento Home Show and the Arizona Family Women's Expo, it is unclear how many customers and potential customers made unfavorable comments regarding non-elastic pockets on other types of pocket caddies but made favorable statements about the elastic of Applicant's pockets. In addition, it is unclear whether the customers were asked about the problems with non-elastic pockets before they commented on the difference between elastic and non-elastic pockets.

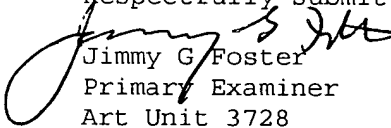
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The examiner has not been persuaded that the **Cohen** declaration demonstrates long-felt need. In fact, the declaration appears to indicate that the need is not long felt. The declaration calls for the unmet need to be unrecognized (part 11). For long felt need to be existent, it certainly must have been recognized.

In addition, Gary Cohen does not cite facts and dates that would indicate that there was a long-felt need existent. The declaration is merely conclusion.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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JGF

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